

### **REMARKS**

In the Office Action, the Examiner rejected claim 19 under 35 U.S.C. § 112, first paragraph; rejected claims 1, 9, 17, 19, 20, and 28-34 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,758,259 to Lawler ("*Lawler*") in view of U.S. Patent No. 6,029,176 to Cannon ("*Cannon*"); and rejected claim 27 under 35 U.S.C. § 103(a) as unpatentable over *Lawler* and *Cannon* in view of U.S. Patent Application Publication No. 2002/0007368 to Lee et al. ("*Lee*").

By this amendment, Applicants propose to amend claims 1, 9, 17, and 31. Applicants note that the proposed amendments to independent claims 1, 9, and 17 incorporate subject matter from pending dependent claim 31, and therefore do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner.

#### **I. The Rejection of Claim 19 under 35 U.S.C. § 112, first paragraph**

The Office Action alleges that claim 19 lacks support in the specification (Office Action at pp. 3-4). Claim 19 recites, in full:

The server operational expenses collecting method according to claim 1, wherein the second electronic programming guide includes a group of programs that the first viewer absolutely wishes to view.

The Office Action states that the specification describes "programs the user wants to view without fail" and calls these groups an "absolute viewing program group" (Office Action at pp. 3-4). However, the Office Action suggests using "the actual terms found within the specification" (Office Action at p. 4).

Applicants respectfully refer the Examiner to M.P.E.P § 2173.05(e), which states:

There is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.

(emphasis added). Although the words of claim 19 do not exactly match those used in the specification, claim 19 is fully supported. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection under 35 U.S.C. § 112, first paragraph.

**II. The Rejection of Claims 1, 9, 17, 19, 20, and 28-34 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 1, 9, 17, 19, 20, and 28-34 under 35 U.S.C. § 103(a).

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See id. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145.

Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made.

M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the

claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1996) . . . . The factual inquires . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III). In this application, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Independent claim 1, for example, recites a server operational expenses collecting method. The method comprises, among other things, “generating first viewer tendency information for a first viewer on the basis of a program viewing log ... wherein the first viewer tendency information includes values for titles of the programs viewed by the first viewer” (emphasis added).

*Lawler* discloses a method of identifying a preferred program for a viewer of interactive television (*Lawler*, abstract). *Lawler* discloses that the program is identified based on a database of viewer preferences that includes characteristics of programming that the viewer selects or receives (*Lawler*, col. 5, lines 52-56). *Lawler’s*

database represents a viewing history that includes certain “predetermined characteristics” of programming transmitted over the interactive television system (*Lawler*, col. 5, line 56 to col. 6, line 1).

In addressing dependent claim 31, the Office Action relies on *Lawler’s* “predetermined characteristics” as allegedly corresponding to the claimed “values for titles” (See Office Action at p. 8). However, while *Lawler’s* characteristics include information such as the names of individuals in the programming and the genre of the programming (*Lawler*, col. 6, tables 1A and 1B), *Lawler* does not disclose that the predetermined characteristics include titles of programs viewed over the interactive television system. Therefore, *Lawler* does not teach or suggest “generating first viewer tendency information for a first viewer on the basis of a program viewing log ... wherein the first viewer tendency information includes values for titles of the programs viewed by the first viewer” as recited by independent claim 1 (emphasis added).

*Cannon* fails to cure the deficiencies of *Lawler*. *Cannon* discloses a “method and apparatus for quickly and easily retrieving, manipulating and analyzing large quantities of computer-based data relevant to television-viewing consumers” (*Cannon*, abstract). *Cannon* also discloses displaying a pie chart that represents audience flow for a series of programs, and a user can select a title to show other information about an episode of the program such as total ratings or share (*Cannon*, col. 26, lines 39-47 and FIG. 12). However, *Cannon* does not disclose that the titles are used to generate or included in viewer tendency information. Therefore, *Cannon* does not teach or suggest “generating first viewer tendency information for a first viewer on the basis of a program viewing log ... wherein the first viewer tendency information includes values for titles of the

programs viewed by the first viewer” as recited by independent claim 1 (emphasis added).

Because the cited references fail to teach or suggest each and every claim element, no *prima facie* case of obviousness has been established with respect to claim 1. Independent claims 9 and 17 distinguish over *Lawler* and *Cannon* for at least the same reasons as claim 1. Claims 19, 20, and 28-34 depend from claim 1, and are allowable at least due to their dependence. Applicants therefore respectfully request the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

**III. The Rejection of Claim 27 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claim 27 under 35 U.S.C. § 103(a) as unpatentable over *Lawler* and *Cannon* in view of *Lee*.

**A. *Lee* is not prior art against the claims of this application**

This application claims priority under 35 U.S.C. § 119 to Japanese Patent Application No. 2000-309796, filed October 10, 2000. Applicants submitted a certified translation of JP 2000-309796 on March 13, 2008, as required by 37 C.F.R. § 1.55. Applicants' priority date of October 10, 2000, antedates *Lee*'s filing date of July 12, 2001

**B. The cited art does not teach or suggest all of the features of claim 27**

Claim 27 depends from claim 1. As already discussed, *Lawler* and *Cannon* fail to teach or suggest certain features of claim 1.

*Lee* discloses a “method for processing description information of multimedia data” (*Lee*, abstract). *Lee*'s method reflects “a user's preference about multimedia data,” and a “usage history is made by adding description information to the multimedia data” (*Lee*, abstract). However, *Lee* does not teach or suggest “generating first viewer

tendency information for a first viewer on the basis of a program viewing log ... wherein the first viewer tendency information includes values for titles of the programs viewed by the first viewer” as recited by independent claim 1 (emphasis added).

For at least the reasons discussed above, no *prima facie* case of obviousness has been established with respect to claim 27, at least to its dependence from claim 1. Applicants therefore respectfully request the Examiner to withdraw the rejection of claim 27 under 35 U.S.C. § 103(a).

#### **IV. Conclusion**

Applicants respectfully request that the Examiner enter this Amendment under 37 C.F.R. § 1.116. Applicants submit that the proposed amendments to claims 1, 9, 17, and 31 would place the application in condition for allowance and do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. In the alternative, the proposed amendments at least place the application in better form for appeal.

In view of the foregoing remarks, Applicants respectfully request reconsideration of the application and withdrawal of the rejections. The pending claims are in condition for allowance.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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